

The essential feature of the present invention resides in that the melt viscosity of the material for the inner layer relative to that of the material for the outer layer is adjusted within the prescribed range, and does not reside in a selection of kinds of materials for the inner and outer layers.

The rejection of claims 1 and 16 "under 35 U.S.C. 112, second paragraph" is respectfully traversed. These claims have been amended to overcome this ground of rejection, as required.

The rejection of claims 1, 2, 7 to 9, 14, 18 and 19 "under 35 U.S.C. 102(b) as being anticipated by Yokoe et al. ..." is also respectfully traversed. The claimed invention would neither be anticipated by nor obvious from any reference merely showing materials for the inner and outer layers. There is no reason to believe that the ratio of melt viscosity between fluororesin and thermoplastic resin in Yokoe's fuel hose is within the range claimed in Applicants' claim 1. Yokoe fails to provide information sufficient to ascertain the melt viscosity of his polymer, and that called for by Applicant's claim 1 is certainly not inherent.

Inherency may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *Hansgirk v. Kemmer*, 40 U.S.P.Q. 665, 667 (CCPA 1939); *In re Oelrich and Vivigard*, 212 U.S.P.Q. 323, 326 (CCPA 1981).

Anticipation by inherency requires that 1) the missing descriptive matter be "necessarily present" in the prior art reference and that 2) it would be so recognized by persons of ordinary skill in the art. *Continental Can Co. v. Monsanto Co.*, 20 U.S.P.Q. 2d 1746, 1749 (Fed. Cir. 1991).

The rejection of 3 to 6, 10 to 13, 15 and 17 "under 35 U.S.C. 103(a) as being unpatentable over Yokoe et al." is also respectfully traversed in the same manner and for the same reasons as set forth in the preceding remarks. Moreover, any optimization is based upon established knowledge that a particular property is optimized by such variation. Without that established knowledge, there is no reason to believe that one would merely experiment with any particular properties without any purpose in mind.

Although the statement for this ground of rejection does not include reliance upon Spohn, it appears that reliance is also being placed on that reference in combination with Yokoe. Yokoe does not show or suggest that the ratio of melt viscosity between the materials for the inner and outer layers affects the formation of each layer having a uniform thickness. On the other hand, Spohn uses fluoroolefin to produce a fuel hose with chemical resistance, and does not suggest adhesion to the polyamide layer.

There are perhaps thousands of references in related art. Nothing is found in either of these references that would lead any artisan to their combination for any purpose whatsoever.

Moreover, there is nothing that would lead any artisan to selecting the particular elements of each for combination in the manner proposed in view of Applicants' disclosure. For an understanding of current criteria for combining references, attention is respectfully directed to the opinion for *In re Lee*, 61 U.S.P.Q. 1430 (Fed. Cir. 2002), at 1433 and 1434:

"The factual inquiry whether to combine references must be thorough and searching." It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. "[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed". The Examiner can satisfy the burden of showing obviousness of the combination "only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would leave that individual to combine the relevant teachings of the references". The Board rejected the need for "any specific hint or of suggestion in a particular reference" to support the combination of the two references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action.

The rejection of claim 16 "under 35 U.S.C. 103(a) as being unpatentable over Yokoe et al. ... in view of Murakami et al. ..." is also respectfully traversed in the same manner and for the same reasons as set forth in the preceding remarks. Murakami does not in any way overcome the previously noted deficiencies of Yokoe.

The rejection of claim 20 "under 35 U.S.C. 103(a) as being unpatentable over Yokoe et al. ... in view of Stanley ..." is also respectfully traversed in the same manner and for the same reasons

as set for in the preceding remarks. Stanley does not in any way overcome the previously noted deficiencies of Yokoe.

Please note that it is only when the general conditions of a claim are disclosed in prior art that it is not inventive merely to discover the optimum working ranges by routine experimentation. *In re Aller, Lacey and Hall*, 105 U.S.P.Q. 233, 235 (CCPA 1955). In other words, the general properties that could be achieved must be apparent from prior art before optimization negatives patentability. Exceptions to the rule that the discovery of an optimum value of a variable in the known process is normally obvious include cases in which the parameter optimized was not recognized to be a result-effective variable. *In re Antonie*, 195 U.S.P.Q. 6, 8, 9 (CCPA 1977).

Having overcome all outstanding grounds of rejection, the subject application is now in condition for allowance, and early action toward that end is respectfully solicited.

Respectfully submitted,

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IMA:jmp/lms

Date: May 19, 2003

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